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10/002,799	11/02/2001	John Joseph King	LF 102US	3842

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John J. King
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EXAMINER

DIVECHA, KAMAL B

ART UNIT	PAPER NUMBER
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2151

DATE MAILED: 02/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/002,799

Applicant(s)

KING ET AL.

Examiner

KAMAL B. DIVECHA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/02/2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) 1-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/02/2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Claims 1-20 are cancelled by the applicant.

Claims 21-49 are presented for the examination.

Priority

Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged.

Information Disclosure Statement

The information disclosure statement (IDS) has been considered by the examiner.

Specification

The disclosure is objected to because of the following informalities: The references provided on the first page of the disclosure needs to be updated with the current status of the incorporated references with the appropriate application number and patent number or publication number.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 21, 22, 24-27, 29-35, 41, 43-46 and 49 are rejected under 35 U.S.C. 102(e) as being anticipated by Shin et al (U. S. Patent No. 6,674,439 B1).

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As per claim 21, Shin et al discloses: A method of enabling the designation a picture file on a cellular telephone (col. 11 L44-56), said method comprising steps of: receiving said picture file at said cellular telephone (fig. 1 item #10, 11 and fig. 6 step #s109; col. 12 L41-42); displaying said picture file on a display of said cellular telephone (fig. 6 step # s116; col. 12 L60-63); and providing a selection option (read as option for selecting an image) associated with said picture file when said picture file is displayed on said cellular telephone (fig. 12 item #s214, s215, s216; fig. 19; col. 12 L45-52; col. 7 L1-5).

As per claim 22, Shin et al discloses the method as in claim 21 wherein said step of receiving said picture file at said cellular telephone comprises receiving said picture file by way of a wireless link of a telecommunications network (col. 9 L50-59 and fig. 1 item #20).

As per claim 24, Shin discloses the method as in claim 21 further comprising a step of storing said picture file on said cellular telephone (col. 12 L42-44; col. 13 L50-58; fig. 12 step # S220; fig. 6 step # S110).

As per claim 25, Shin discloses the method as in claim 21 wherein said step of providing a selection option comprises providing a selection box associated with said picture file which can be selected by a user (fig. 19 and fig. 17; fig. 20 item # S410).

As per claim 26, Shin et al discloses Shin et al discloses: A method of enabling the designation a picture file on a cellular telephone (col. 11 L44-56), said method comprising steps of: storing a picture file on said cellular telephone (col. 4 L47-60; col. 15 L3-5; fig. 6 step # S110); displaying said picture file on a display of said cellular telephone (fig. 6 step # s116; col. 12 L60-63); providing a selection option associated

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with said picture file when said picture file is displayed on said cellular telephone (fig. 12 item #s214, s215, s216; fig. 19; col. 12 L45-52; col. 7 L1-5); and enabling a user to designate (defined as step of marking or pointing out) said selection option while said picture file is displayed on said cellular telephone (fig. 19 item #S1901 {a marking} and fig. 17; col. 19 L5-14; col. 13 L34-41; col. 18 L35-64).

As per claim 27, Shin et al discloses the method as in claim 26 further comprising a step of receiving said at least one picture file by way of a wireless link of a telecommunications network (col. 9 L50-59; fig. 1 item #20).

As per claim 29, Shin et al discloses the method as in claim 26 wherein said step of enabling user to designate said selection option further comprises a step of enabling a user to select a function for presenting said picture file (fig. 20 item # S410 and fig. 6 item # S116; fig. 6 item # S112 and S116).

As per claim 30, Shin et al discloses the method as in claim 26 further comprising a step of enabling said user to enlarge (read as displaying a full version of image in a display area) said picture file (fig. 6 step # S111, S112 and fig. 19, and fig. 6 step # S116: user selects an image from fig. 19 by focusing in any one image, the size is compared with the size of display area, and if the size of the image does not exceed effective display area, focused image is displayed or enlarged in the effective display area of the display; col. 3 L1-61; col. 12 L64-67 and col. 14 L26-35).

As per claim 31, Shin et al discloses Shin et al discloses: A method of enabling the designation a picture file on a cellular telephone (col. 11 L44-56), said method comprising steps of: displaying said picture file on a display of said cellular telephone (fig. 6 step # s116; col. 12 L60-63); providing a selection option associated with said

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picture file when said picture file is displayed on said cellular telephone (fig. 12 item #s214, s215, s216; fig. 19; col. 12 L45-52; col. 7 L1-5); enabling a user to designate said selection option while said picture file is displayed on said cellular telephone (fig. 19 item #S1901 {a marking} and fig. 17; col. 19 L5-14; col. 13 L34-41; col. 18 L35-64); and enabling a user to enlarge said picture file (fig. 6 step # S111, S112 and fig. 19, and fig. 6 step # S116: user selects an image from fig. 19 by focusing in any one image, the size is compared with the size of display area, and if the size of the image does not exceed effective display area, focused image is displayed or enlarged in the effective display area of the display; col. 3 L1-61; col. 12 L64-67 and col. 14 L26-35).

As per claim 32, Shin et al discloses the method as in claim 31 wherein said step of displaying a picture file on a cellular telephone comprises displaying a thumbnail (defined as a miniature version of an image) of said picture file (fig. 17: the miniature version of images are displayed and further would have been focused or selected in order to display the full version).

As per claim 33, Shin et al discloses the method as in claim 32 wherein said step of enlarging said picture file comprises a step of displaying said picture file as a window on a display of said cellular telephone (fig. 5 and fig. 6 item # S116).

As per claim 34, Shin et al discloses the method as in claim 31 further comprising a step of enabling the selection of said picture file (fig. 18, fig. 19, fig. 20 and fig. 17).

As per claim 35, Shin et al discloses the method as in claim 31 further comprising a step of presenting said picture file having a designated selection option according to a user selectable function (fig. 6 item # S116 and fig. 19 and fig. 20 item # S410).

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As per claim 41, Shin et al discloses: A cellular telephone capable display a picture file (fig. 1 item #10 and fig. 2), said cellular telephone comprising: a control circuit (fig. 2 item #25); a memory coupled to said control circuit and storing said picture file (fig. 2 item #32 and #33 and fig. 6 item # S110); a user interface coupled to said control circuit and enabling the user to access said picture file (fig. 2 #28 and fig. 4 item #401 and item #407); a display coupled to said control circuit and displaying said picture file and selection option associated with said picture file (fig. 2 item #29 and fig. 4 item #413, 412 and 409 and fig. 19).

As per claim 43, Shin et al discloses the cellular telephone as in claim 41 further comprising an icon on said display, said icon enabling access to said picture file when said icon is selected (fig. 17 and fig. 19 and fig. 6 item #S116).

As per claim 44, Shin et al discloses the cellular telephone of claim 41 further comprising a plurality of picture files stored in said memory (col. 4 L47-60; col. 15 L3-5).

As per claim 45, Shin et al discloses the cellular telephone of claim 41 further comprising a plurality of selection boxes, each said selection box stored with a picture file of said plurality of picture files (fig. 17 item #1601, 1602 and 1603 and associated pictures).

As per claim 46, Shin et al discloses the cellular telephone of claim 41 wherein said selection box enables a user to select a function for displaying said picture file (fig. 17 and fig. 19).

As per claim 49, Shin et al discloses the cellular telephone of claim 41 wherein said picture file comprises a thumbnail (fig. 17).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 23 and 28 are rejected under 35 U.S.C. 103(a) as being obvious over Shin et al (U. S. Patent No. 6,674,439 B1) in view of Rudy et al. (U. S. Patent No. 6,360,252 B1).

As per claim 23, Shin et al does not explicitly disclose the method as in claim 21 wherein said step of receiving said picture file at said cellular telephone comprises receiving said picture file as an attachment to an email.

Rudy et al., from the same field of endeavor, explicitly discloses the method wherein client machine (read as mobile telephone, col. 3 L39-42) receives the client version of email with descriptor of attachment (attachments contain images, text, video, multimedia documents, etc, col. 1 L25-28: read as receiving image file as attachment to an email, fig. 1 item #20 and #12 and col. 7 L49-53; col. 1 L64-67 to col. 2 L1-10).

Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to incorporate the teaching of Rudy as stated above with the information terminal device of Shin in order to receive the picture file as an attachment to an email.

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One of ordinary skilled in the art would have been motivated because the technique would have used where there is a low bandwidth connection between the server and a users mobile device, where there is a high latency connection or where there is a unreliable or intermittent connection. In addition, the technique would have been advantageous because it would have been used where the client machine or a mobile telephone is not adequate to render most attachments due to storage limitations or due to inadequate output capabilities, such as small display or display with inadequate resolution (Rudy, col. 4 L49-61).

As per claim 28, it does not teach or further define over the limitations in claim 23. Therefore, claim 28 is rejected for the same reasons as set forth in claim 23.

5. Claims 36-40 are rejected under 35 U.S.C. 103(a) as being obvious over Shin et al (U. S. Patent No. 6,674,439 B1) in view of Sinclair et al. (U. S. Patent No. 6,554,707 B1).

As per claim 36, Shin discloses: A method of enabling the designation a picture file on a cellular telephone (col. 11 L44-56), said method comprising steps of: storing a plurality of picture files on said cellular telephone (col. 4 L47-51; col. 15 L3-4); displaying said plurality of picture files as thumbnails (read as miniature version of an image) on said cellular telephone (fig. 17 and col. 2 L13-32 and fig. 11); and enabling a user to designate said selection option while said picture file is displayed on said cellular telephone (fig. 19 item #S1901 {a marking} and fig. 17; col. 19 L5-14; col. 13 L34-41; col. 18 L35-64), however, Shin does not explicitly disclose the step of providing a

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plurality of selection options, each selection option being associated with a picture file of said plurality of picture files.

Sinclair, from the same field of endeavor, discloses and teaches the method of providing a plurality of selection options associated with a new game (game consists plurality of pictures or images, col. 5. L3-33; col. 7 L10-22; fig. 17E item #1736).

Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to incorporate the teaching of Sinclair as stated above with the information terminal device of Shin in order to provide a plurality of selection options associated with a picture file.

One of ordinary skilled in the art would have been motivated because the utilization of menu text presentations and icon display elements combined with hypertext user selectable menu items significantly ameliorates or substantially overcomes the complexities and difficulties of typing in free text commands on a mobile station keyboard (Sinclair, col. 13 L22-28). It would have also provided a user controlled scheme for controlling the information stored in a mobile device by providing a selection options and functions with the associated image or image file.

As per claim 37, Shin discloses a step of receiving at least one picture file of said plurality of picture files by way of a wireless link of telecommunications network (col. 9 L50-59 and fig. 1 item #20).

As per claim 38, Shin discloses a step of enabling the selection a picture file of said plurality of picture files (col. 18 L57-64).

As per claim 39, Shin further discloses a step of enabling the enlargement of said picture file (col. 3 L1-61).

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As per claim 40, Shin further discloses a step of enabling a user to designate a selection box to select a display feature (fig. 19 and fig. 6 step #S112 and S116).

6. Claims 42, 47 and 48 are rejected under 35 U.S.C. 103(a) as being obvious over Shin et al (U. S. Patent No. 6,674,439 B1) in view "Official Notice".

As per claim 42, Shin does not explicitly disclose the cellular telephone of claim 41 wherein said selection option comprises a check box, but, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made modify Shin and include a check box in the selection option. One of ordinary skilled in the art would have been motivated because this would have enabled user-selected action to be performed on the cellular telephone.

As per claim 47, Shin does not explicitly disclose the cellular telephone of claim 41 wherein said user interface enables the selection of said selection box, but, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to say that the user interface enables the selection of selection box. One of ordinary skilled in the art would have been motivated because user would have selected or checked the selection box through the user interface.

As per claim 48, Shin et al discloses an information terminal device (read as cellular telephone, fig. 1 item #10 and 11) comprising an input unit (read as user interface) coupled to a display unit (fig. 4 item #401 and 413), however, Shin does not explicitly disclose the method where user interface enables the user to enlarge the picture file (read as displaying the full version of the picture). But, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to expressly

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include the limitation where user interface enables the user to enlarge the picture file.

One of ordinary skilled in the art would have been motivated because it would have enabled the user to present or display the picture in its full version.

Additional References

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Anderson U. S. Patent No. 5,933,137.
- b. Obradovich et al. U. S. Patent No. 6,542,812 B1.
- c. Reitmaa et al. U. S. Patent No. 6,424,843 B1.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KAMAL B. DIVECHA whose telephone number is 571-272-5863. The examiner can normally be reached on 9.00am-5.30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on 571-272-3939. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Zarni Maung', with a long horizontal flourish extending to the right.

ZARNI MAUNG
SUPERVISORY PATENT EXAMINER